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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,316	09/25/2001	Toshio Imai	TOYAM77.001AUS	I352
7590	02/23/2004		EXAMINER	VANDERVEGT, FRANCOIS P
CHOATE, HALL & STEWART PATENT DEPARTMENT EXCHANGE PLACE 53 STATE STREET BOSTON, MA 02109			ART UNIT	PAPER NUMBER
			1644	
DATE MAILED: 02/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/963,316	IMAI ET AL.	
	<b>Examiner</b> F. Pierre VanderVegt	<b>Art Unit</b> 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 December 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12-15 and 17-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-11 and 16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 04092002.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

#### **DETAILED ACTION**

The Examiner in charge of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to F. Pierre VanderVegt, Ph.D. in Art Unit 1644.

Claims 1-14 were originally pending.

Claims 15-20 have been added.

Claims 1-20 are currently pending.

#### *Election/Restrictions*

1. Applicant's election **without traverse of the invention of Group V**, claims 9-11, drawn to a method of treating an autoimmune disease by administration of an antibody to fractalkine, in the Paper filed December 1, 2003 is acknowledged. Because applicant did not distinctly and specifically point out errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's further election **without traverse of the species of multiple sclerosis** as the autoimmune disease being treated in the Paper filed December 1, 2003 is acknowledged. Because applicant did not distinctly and specifically point out errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

**Claims 1-8 and 12-14 are withdrawn** from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without traverse** in the Paper filed December 1, 2003.

2. It is noted that Applicant has added new claims 15-20, each of which recites an autoimmune disease to be treated by the method of claim 9. Accordingly, claims 15-20 read upon the invention of Group V and are included in Group V, which now comprises claims 9-11 and 15-20. However, only claim 16 is drawn to the elected species of multiple sclerosis.

**Claims 15 and 17-20 are withdrawn** from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without traverse** in the Paper filed December 1, 2003.

Accordingly, **claims 9-11 and 16 are the subject of examination** in the present Office Action.

***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9-11 and 16 rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 6,013,257 to Pan et al (A on form PTO-892) as evidenced by Hoover et al. (J. Biol. Chem. [2000] 275(30):23187-23193; U on form PTO-892).

The claims are drawn to the treatment of an autoimmune disease, specifically multiple sclerosis, using an antibody specific for the CX3C chemokine “fractalkine.” It is noted that the protein named herein as “fractalkine” is also commonly known in the art as “neurotactin,” as evidenced by Hoover (Abstract in particular). The ‘257 patent teaches and claims the treatment of multiple sclerosis in a patient with antibodies to human neurotactin, the sequence of which is disclosed in the ‘257 patent as SEQ ID NO: 4 (column 2, lines 21-31; column 34, line 16 through column 35, line 14 and claims 1-4 in particular). The prior art teaching clearly anticipates the claimed invention.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571) 272-0852. The examiner can normally be reached on M-Th 6:30-4:00; Alternate Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Pierre VanderVegt, Ph.D.

Patent Examiner

February 17, 2004



PATRICK J. NOLAN, PH.D.

PRIMARY EXAMINER

